

Appl. No. 10/017,513  
After Final Response dated February 23, 2006  
Reply to Office action of February 22, 2006

### **REMARKS/ARGUMENTS**

Applicants thank examiner Grier for the clearly stated office action of February 22, 2006 removing the rejections over Takahashi et al.

#### **35 U.S.C. § 112 Rejection**

The examiner rejected claims 1-3 under 35 U.S.C. § 112, second paragraph as being indefinite with respect to the claim limitation "a". Applicants thank examiner Grier for pointing out this problem and has accordingly amended this limitation to more clearly point out and define the inventive features which applicants seek to protect. In the event examiner Grier might think of better language to be used in this respect, applicants would be most grateful for any suggestions or examiner's amendments to that effect.

#### **35 U.S.C. § 102(b) Rejection**

The examiner rejected claims 4-9 under 35 U.S.C. § 102(b) as being anticipated by Bittel, 5,014,341. Applicants do not believe that this is the best prior art of that cited and believe it accordingly should be withdrawn unless the examiner is relying of some particular interpretation or teaching (other than those addressed below) which has not been explicitly stated (see MPEP 706.02 I). Applicants wish to request reconsideration of the rejections of these claims in view of the distinctions pointed to below.

The examiner points to Bittel's control desk figures 1 & 2 with respect to claims 4, 7 and 8 as providing a plurality of audio signal input connections "wherein at least one is capable of receiving digital audio signals of different data rates (digital audio signal sources) ... ." Applicant respectfully disagrees. The examiner has not pointed to any specific mention or suggestion by Bittel that any of the digital audio inputs is capable of receiving digital audio signals of different data rates. Even if the different inputs are capable of receiving digital audio at particular rates which are different for each input (which in itself is not suggested or taught by Bittel) that is not what the claims 4, 6/4, 7 and 8 call for. For example, claim 4 calls for "providing a plurality of audio signal input connections, at least one of which is capable of receiving digital audio signals

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of different data rates" that is, one of the inputs is capable of different data rates. Claims 6/4, 7 and 8 have similar language.

The examiner points to Bittel as disclosing "a processing section (11/21) which includes level adjusters, filters, switching members, and monitoring devices, which provides for inherent support of selecting, and processing, therein; the desk is able to output both a digital and analog broadcast signals, which indicates outputting all channels in a plurality of distinct known forms ... ." While the examiner is correct that the Bittel device outputs "all channels in a plurality of distinct known forms" applicants point out that this does not meet claims 5, 6, 9 and 15 which call for selection. The analog broadcast signal and digital broadcast signal are the sum of all of the analog signal sources  $A_1$ - $A_{(n-1)}$  and digital signal sources  $D_1$ - $D_{(n-1)}$  but there is no selection and this is different than the claims. For example, claim 5 calls for "b) selecting one of the audio signals which may be present at one of said input connections of a) which selected audio signal is carried via one or more channels," and "c) processing said selected signal of b) to provide a processed signal carried via one or more channels," and "d) outputting all channels of said processed signal of c) in a plurality of distinct known forms" (emphasis added). Thus the selected one of the audio signals is processed and then all of its channels are output. Channels for example might be the left and right channels of a stereo signal. That claim language is not the same as Bittel where all of the signals are being output as the examiner suggests. Claims 9 and 15 have similar language.

The examiner goes on to state "and further, the processing sections (11/21) includes a monitoring devices, and enables the manipulation of an audio engineer which inherently supports utilizing parameters which are established in manufacture and/or by an operator, therein as claimed. (col. 2, lines 59 - col. 3, lines 50)." Applicants respectfully disagree that Bittel's suggested apparatus anticipates the claimed feature. Bittel's statement at the indicated lines is:

The master control desk shown in the drawings includes an analog portion 10 shown in FIG. 1 and a digital portion 20 shown in FIG. 2. For reasons of clarity, both portions 10 and 20 are separated from one another by a dashed dividing line; however, the two portions are in communication with one another as described below. Analog portion 10 includes a processing section 11 which receives a plurality of analog input signals  $A_1$  to  $A_n$ . 1. As customary, processing section 11 includes level adjusters, filters, switching members, monitoring devices and the like. A processed sum signal of analog input signals  $A_1$  to  $A_{n-1}$  is generated at the output of processing section 11. This sum signal is fed to an analog/digital converter 12 as well as to a summing member 13. Output signal  $D_n$  of

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analog/digital converter 12 is fed to digital portion 20 from which an analog signal  $A_n$  is fed to the second input of summing member 13. As will be explained in greater detail below, the output signal of summing member 13 constitutes the analog broadcast signal.

Digital portion 20 includes a processing section 21 which receives a plurality of digital input signals  $D_1$  to  $D_{n-1}$ . These digital audio signals generally originate from digital audio signal sources such as, for example, CD players, DAT recorders or digital signal lines (e.g. from the Federal Postal Service). In a simple version, digital processing section 21 is composed only of level adjusters since the feeding in of signals from digital audio signal sources other than a level control requires no further processing, such as, for example filtering. If necessary, processing section 21 may of course also contain digital filters, switching devices and the like.

Processing section 21 further includes monitoring devices such as, for example, an audition key, a digital display of transmission level and many more. The processing of processing section 21 is, as already mentioned above, incorporated into the processing of processing section 11 so that the operating philosophy of analog master control desks to which the audio engineer is accustomed is available.

The sum signal of the processed input signals  $D_1$  to  $D_{n-1}$  is present at the output of processing section 21 and is fed to a digital/analog converter 22 and to a summing member 23. The output signal  $D_n$  of analog/digital converter 12 of analog portion 10 is present at the second input of summing member 23, which is equivalent to the digitalized version of the sum of the processed analog signals and is added to the sum of the processed digital signals. As already mentioned, the output signal  $A_n$  of digital/analog converter 22 is fed to the second input of summing member 13 of analog portion 10. This means the analog version of the sum of the processed digital signals is fed to the sum of the processed analog signals. The output signal of summing member 23 constitutes the digital broadcast signal. If one compares the broadcast signals at the outputs of summing members 13 and 23, it will be noted that both signals

- (a) contain the sum of the processed analog signals  $A_1$  to  $A_{n-1}$  ; and
- (b) the sum of the processed digital signals  $D_1$  to  $D_{n-1}$ .  
(emphasis added).

It can be seen that all Bittel says about processing the inputs is that the analog inputs include level adjusters, filters, switching members, monitoring devices and the like and the digital inputs include level adjusters and if necessary, processing section 21 may of course also contain digital filters. Processing section 21 further includes monitoring devices such as, for example, an audition key, a digital display of transmission level and many more. There is no mention of any automatic operation of any of these. There is no mention of selection of inputs.

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Nowhere in his teachings does Bittel suggest "utilizing parameters which are established in manufacture and/or by an operator such that at least one of the selecting of step b) and the processing of step c) automatically changes in response to at least one signal present on one said input connection of a)" as claimed in claim 5. Claim 6 depends from 5 and claims, 9 and 15 have similar language.

It is believed that the operations and features the examiner has ascribed to 35 U.S.C. § 102(b) rejections of claims 4-9 as discussed above amount to hindsight reconstruction as discussed in *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n.5 (Fed. Cir. 1986) (with respect to 103 rejections) "The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention" See MPEP 2141.01 III. For example the examiner points to Bittel as capable of receiving digital audio signals of different data rates whereas there is no suggestion or support in Bittel for this capability. The examiner points to Bittel as inherently supporting utilizing parameters which are established in manufacture and/or by an operator, therein as claimed whereas there is no suggestion or support for the claimed automatic change in response to a selected signal. Applicant submits that such is clearly improper hindsight construction.

#### Premature Final Rejection

As provided in MPEP 706.07(a):

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

It is believed that the examiner introduced a new ground of rejection, and new reference by Bittel, which was not necessitated by applicant's amendment.

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As set forth in MPEP 706.07:

Switching from one subject matter to another in the claims presented by applicant in successive amendments, or from one set of references to another by the examiner in rejecting in successive actions claims of substantially the same subject matter, will alike tend to defeat attaining the goal of reaching a clearly defined issue for an early termination, i.e., either an allowance of the application or a final rejection.

Here the examiner has switched from one reference to another in rejecting substantially the same subject matter. Applicants submit that the final rejection is premature in view of this new ground of rejection and new prior art.

In view of the inapplicability of the only remaining prior art as discussed above it is respectfully requested that the pending claims be allowed and the application be passed to issue. Alternatively, in the event that all claims are not allowed it is requested that the holding of final rejection be withdrawn in order to allow "... reaching a clearly defined issue ..." and as set forth in MPEP 706.07 with respect to the proper interpretation of Bittel and/or proper interpretation of the claims.

In that the application is believed in form for allowance, further action in that respect is respectfully solicited.

Respectfully Submitted,



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I hereby certify that this correspondence is being facsimile transmitted to the U.S. Patent and Trademark Office, Fax No. (571) 273-8300 on February 23, 2006.



J. Carl Cooper